

Remarks

Claims 1-44 are pending in the Application. Claims 8 and 36 have had typographical errors corrected. Claim 44 has been added. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

Applicants Provisionally Elect With Traverse

In response to the Office Action dated October 3, 2003 requiring restriction election, Applicants provisionally elect with traverse Group I (claims 1-9). Reconsideration and withdrawal of said restriction requirement is respectfully requested. As shown in more detail herein, the restriction requirement is without legal basis.

New claim 44 includes the subject matter of claims 1 and 36. It follows that claims 1 and 36 (i.e., Groups I and VII) are not separable from claim 44, nor each other. Nor are the alleged Groups I and II distinct. Thus, Applicants respectfully submit that claim 44 should be placed in the alleged Group I along with claims 1-11 and 36-41.

The Alleged Groups

Claims 1-44 are pending. The Action alleges eight distinct Groups:

- | | | | |
|------|--------------|-------|--------------|
| I. | Claims 1-9 | V. | Claims 30-31 |
| II. | Claims 10-11 | VI. | Claims 32-35 |
| III. | Claims 12-24 | VII. | Claims 36-41 |
| IV. | Claims 25-29 | VIII. | Claims 42-43 |

Reasons For Insisting On Restriction Have Not Been Established

The Office has not shown an appropriate explanation for insisting upon restriction. The Office has not met the criteria of serious burden. The Office has shown neither separate classification, separate status in the art, or a different field of search. If the search and examination of an entire application can be made without serious burden (which is the current situation), then the Office must examine all the claims on the merits. Thus, the Applicants respectfully submit that the restriction requirement should be withdrawn and that all of the claims should be examined on the merits.

The Alleged Groups Are Not Distinct

The Action has not presented reasons why the alleged inventions as claimed are either independent or distinct. Nor has the Action shown, by way of any valid example (MPEP § 806.05 - § 806.05(i)) distinctness between the alleged inventions. The Action makes mere statements of conclusion, which is not a valid basis for restriction requirement. Applicants respectively traverse the restriction requirement on the grounds that the reasons given for asserting distinctness are insufficient to satisfy a restriction requirement. Again, it is respectfully submitted that the restriction requirement should be withdrawn.

Group I and Groups II-V

The Action alleges that Group I and Groups II-V are related as subcombinations usable together in a single combination.

Applicants respectfully disagree. "The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. Care must be taken to

determine if the subcombinations are generically claimed." "The burden is on the examiner to provide an example. If Applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement." MPEP § 806.05 (d).

Applicants respectfully submit that the Action has not shown any example that one of the alleged subcombinations has utility other than in the disclosed combination. The Action has not shown that one Group I can be used separately from each of Groups II-VIII. No example of "separate utility" has even been presented. The Action (e.g., page 10, lines 3-7) has improperly alleged distinctness based solely on the presented definitions of the Groups, which definitions in turn apparently repeat the language of the independent claims. However, this is not a valid basis for restriction requirement. Rather, as previously noted, the Office must show, by way of example, that one of the alleged subcombinations has utility other than in the disclosed combination. With the Office's presented reasoning for restriction, no application could have more than one independent claim, because independent claims (like in the present application) would always be alleged as distinct. Applicants have shown that another use (which the Action lacks) is not reasonable. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group I and Groups VI-VIII

Additionally, the Action is devoid of any example of separate utility regarding Group I and Groups VI-VIII. Again, in order to establish a valid basis for restriction, the examiner must show, by way of example for each pairing of Groups, that one of the alleged subcombinations has

utility other than in the disclosed combination. The burden is on the Office to provide a valid example. No example has even been presented. Thus, Applicants respectfully submit that the burden imposed on the Office has not been met. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Other Groupings II-VIII

The Action also does not provide any example for the other alleged Groupings. Where are the examples for each of Groups II / III-VIII; III / IV-VIII; IV / V-VIII; V / VI-VIII; VI / VII-VIII; and VII / VIII? In order to establish a valid basis for restriction, the examiner must show, by way of example for each pairing of Groups (e.g., Group II and Group III), that one of the alleged subcombinations has utility other than in the disclosed combination. Again, the Office has not met the required burden. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Other Reasons Rebutting The Alleged Distinctness

The Action apparently alleges that all of the Groups are subcombinations pursuant to MPEP § 806.05 (d). Applicants respectfully disagree. It is unclear how the Office can relate an apparatus (e.g., Group I) and a method (e.g., Group IV) as subcombinations allegedly usable together in a single combination. Nor has any showing been provided. Thus, no basis has been provided for alleging distinctness between apparatus/method subcombinations. On this basis it is further respectfully submitted that the restriction requirement should be withdrawn.

Rejoinder

The Action has not addressed the issue of rejoinder of claims (MPEP § 821.04).

Applicants respectfully submit that even if the claims were somehow directed to different Groups as alleged, that the process claims would still be entitled to rejoinder. Applicants reserve all rights to rejoinder.

The Restriction Requirement Is Without Legal Basis

Applicants additionally respectfully wish to point out that the Action fails to state a legally proper test for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being “distinct.” Applicants also respectfully wish to point out that the Action fails to state a legally sufficient basis for imposing a restriction requirement. The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both “independent” and “distinct.” The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

In the Action, there are only unsupported assertions that the sets of claims are “distinct.” There are no assertions that the sets of claims are “independent”, as is required. This standard does not comply with the statutory requirements. Therefore the reasons asserted in the Action for seeking to impose the restriction requirements are legally insufficient due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder.

Furthermore, the Patent Office has acknowledged that before claimed inventions can be considered to be “independent” the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. All the claims directed to Applicants’ invention are related in design, operation, and effect. Thus, the statutory requirements are not met and no restriction requirement may be imposed.

Conclusion

The restriction requirement is respectfully traversed. The alleged Groups are not distinct. Therefore, it is respectfully requested that the restriction requirement be withdrawn.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,


Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000